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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,095	06/19/2001	Stephen Thomas Blocher	END920010013US1	2413

23550 7590 11/17/2006

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EXAMINER

BROOKS, MATTHEW L

ART UNIT PAPER NUMBER

3629

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/884,095	Applicant(s) BLOCHER ET AL.	
	Examiner Matthew L. Brooks	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added matter places on the template "an occurrence of the risks". Examiner has searched the originally filed specification and can find no support for the term. Further still the preamble is a method to "identify and address risks"; NOT the occurrence thereof. Further still, Applicant's canceling of claim 2 is quasi-suspicious in that the template dealt with, identifying actions to address the risks and arranging on said template, then perform an audit using said template; nowhere is mentioned placing "occurrence of the risks on the template"

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-29** are rejected under 35 U.S.C. 102(b) as being clearly anticipated and taught by the public activities of Keane Inc. as of May 5th, 2000 as shown by their web Homepage as of said date and "PRAM it or walk away"; Gray, Neal; Transactions of AACE International; pp: r5-48; 1998. (PRAM)

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3. With respect to **Claim 1 and 7, 8, 9 and 10**: PRAM discloses

A computer implemented method for reviewing a business process to identify and address risks, comprising the step of:

providing a business process {see whole document};

identifying risks in the business process as control points {see pg A, iv and v; and pg B, v as soon as the risks are identified and placed on a template they become control points; ie see D, figure 3; this is further supported by the definition of "control point as known in the art and Applicant's definition found on pg 8, "Control Point" – a risk identified in a business process that should be addressed"}; and

arranging information pertaining to the control points (this is the equivalent to arranging information pertaining to the risks such as what they are and how to mitigate) in a standard format using a template and storing the template in a computer database to provide subsequent access to the template, wherein the information comprises a set of tests to be performed by a test entity, and wherein the set of tests identify an occurrence of the risks in the business process. {Pg A, PRAM C1, line 7 states "the problem was "never written down" and Pg C, (v) 1 page for graphical visualization; and pg D, fig 3 Keane is a consultant/auditor/test entity which conducts tests and consults/audits companies risks and how to address them via an "e-solutions strategy"/action entity and thus implemented on a computer and audits using a template, inherently if made by computer and stored persons will have access; as to newly added matter "occurrence of the risk" See fig 3, given broadest reasonable

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interpretation of the claimed language, the fig shows a set of tests identifying an occurrence of risks in the business process; ie, Timely Acceptance Sign Off}.

4. With respect to **Claim 2 and 9**: PRAM discloses

identifying actions to address the risks {See fig. 3, 2 "Risk Mitigation Action"};
arranging the identified actions in the template {See fig 3, Risk Profile}; and
performing an audit using the template {see whole document, the reason why a user would create a "risk profile" is to perform and audit, this too is where the step of accessing the template occurs, see also pg B, v; "If there isn't a template, begin making one so that the next time you, or someone else, needs to identify risks you wont have to start from scratch" This is the same as storing a template in a data base to later use/access again.}.

5. With respect to **Claim 3**: PRAM discloses

step of identifying risks comprises the step of implementing a set of tests to identify risks in the business process {pg B, v and vi; "Identify Risks" and "Determine Probability and Consequence"}.

6. With respect to **Claim 4**: PRAM discloses

(NOTE: As for claim 4, the information on the template is considered to be non-functional descriptive data, see above)

a set of tests, wherein the set of tests identify risks in the business process {fig 3}; and

a set of actions, wherein the set of actions address the risks (fig 3).

7. With respect to **Claim 5**: PRAM discloses

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(NOTE: As for claim 5, the information on the template is considered to be non-functional descriptive data, see above)

a business process {See PRAM};

a test entity, wherein the test entity performs the set of tests {See fig 3 and whole document};

an action entity, wherein the action entity performs the set of actions; and audit details {See fig 3 and whole document}.

8. With respect to **Claim 6**: PRAM discloses

(NOTE: As for claim 6, the information on the template is considered to be non-functional descriptive data, see above)

a control point name {pg D, fig 3};

control point revisions { pg D, fig 3};

background information { pg D, fig 3}; and

a control point frequency { pg D, fig 3}.

9. **Claims 10-29** (system, program, method, template) recite the same limitations already discussed above and are rejected on the same analysis.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1-30 rejected under 35 U.S.C. 103(a) as being unpatentable over PRAM in further view of Official Notice.

Claims 1-30 are rejected under 35 U.S.C. 103 as being unpatentable over the PRAM reference. The PRAM reference discloses all of the limitations as discussed above; the method in which nearly all consultants analyzing risk normally use and steps and considerations made (ie; id risk, determine how to mitigate, and keep track on a template). PRAM does not discuss the use of the internet and an access field that includes a hypertext link that would allow direct access to a field as claimed. In determining the obviousness of applying what is generally known in the risk consulting industry to what is known in the world of the Internet one must determine the level of ordinary skill (*Dann v. Johnston*, 425.U.S. 219, 189 USPQ 257 (1976)). The Internet, to one ordinarily skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be for one computer to access and download files from another computer located at a different site

than the first. Using a hypertext link to access such information is widely known by the use of html and linking techniques. Also, the risk consulting industry has utilized computers for years to keep track of accounts and present this data to their customers and employees through GUI's. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the Internet to access the data in one's template/risk profile in a typical risk analysis system such as that taught in the PRAM reference for the purpose of obtaining/editing information. The desirability to do this is clearly to save a customer/employee the time of having to work on paper and pull the template/risk profile each time a user would want to view and or edit the account information; reduce operational costs through more effective information delivery; and improve compliance checking capability.

Response to Arguments

14. Applicant's arguments filed 8/28/2006 have been fully considered but they are either moot or not persuasive.

15. First it should be noted that the thrust of Applicant's previous remarks was that the use of "templates" was novel and not known in risk assessment. In this action and the one previous to, PRAM addresses fully those concerns.

16. In response to pg 19, middle of first full P of Applicant arguments, Applicant state PRAM does not disclose a template that arranges business process data in computer database so that reviewers or auditors can refer to the template to perform duties. To this Examiner disagrees. PRAM teaches the problem in the past was that assumptions/risks were never written down. Further that PRAM teaches a method for

identifying risk, assessing likelihood and impact potential, determining action steps to lesson or eliminate risk consequences, and clearly communicating the findings to customer and development management (pg B, (ii)). PRAM also states "if there isn't a template, begin making one so that the next time you, or someone else, needs to identify risks you wont have to start from scratch." (pg B, (v)); hence stored on database. Then looking at pg C, (v) "the profile puts all the key risks onto one page for easy review and graphical visualization. Hence on a computer so of course there is subsequent access as well. Certainly Applicant cannot argue that Fig 3, was not created with a computer, thus computer implemented.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A. A printout of KEANE's homepage as pulled from the www.archive.org with a 102 (b) date showing Keane was up and running on the web "e-solutions"
- B. Patent No. 6,591,289 merely one reference showing the use of template shared over network was well known in the art.
- C. Professional's Handbook of Financial Risk Management, Lev Borodorsky, Business and Economics 2000, 832 pages; showing defining data requirements that show operational risk exposure as control points was well known, some relevant pages attached herein.
- D. Auditing systems: 5 Star at Merck Sharp and Dohme, James, Phil, (attached)

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLB
11/13/2006



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